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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,253	07/11/2003	Hector Mark Estrada JR.	23792.2	3903

716 7590 10/18/2005

COX SMITH MATTHEWS INCORPORATED  
112 EAST PECAN STREET, SUITE 1800  
SAN ANTONIO, TX 78205-1521

EXAMINER
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PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/618,253

Applicant(s)

ESTRADA, HECTOR MARK

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/11/03</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by Jamison et al (5,062,844) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jamison et al (5,062,844).

Jamison et al disclose each and every structural element of the frame set forth in claims 1-10, a radiolucent body material, as set forth in column 2, lines 45-57, column 3, lines 1-21, a stiffening member embedded in the substantially radiolucent body material, as set forth in column 4, lines 5-27, the frame being annular, arcuate, lightweight, inert with respect to human body or household substances, comprises a polycarbonate compound, autoclave and adapted for attachment of a variety of wire and pin securing device and a second stiffening member embedded in the radiolucent body material; as set forth in column 5, lines 10-60; column 6, lines 16-50; and as best seen in FIGS. 1-11.

Jamison et al teach that the frame comprises a radiolucent carbon fiber and two reinforcing member made of graphite fibers, but is silent as to the beryllium. The claimed phrase "wherein the beryllium stiffening member is embedded in the substantially radiolucent body material" is being treated as a product by process limitation, that is the stiffening member is made of beryllium. As set forth in the MPEP 2113, product by process are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U. S. C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

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Thus, even though Jamison et al is silent as to the process used to mold the stiffening member and frame, it appears that the product in Jamison et al would be the same or similar as that claimed; especially since both applicant's product and the prior art product is made of a radiolucent material (see instant spec at page 6, line 3, line 11.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,428,540	8-2002	Claes et al.
5,891,143	04-1999	Taylor et al.
5,766,173	06-1998	Ross, Jr. et al.
5,275,598	01-1994	Cook


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
October 13, 2005



PEDRO PHILOGENE  
PRIMARY EXAMINER